

Appl. No. 10/043,695
Amdt. dated 3/27/06
Reply to Office Action of 9/26/05

PATENT
Docket: 010110

REMARKS

Claims 1-21 are pending in the present application. Claims 1-21 have been examined and are rejected. In the above amendments, claims 1, 5, 6, 8-19 and 21 have been amended, and new claims 22-24 have been added. Therefore, after entry of the above amendments, claims 1-24 will be pending in this application. Applicant believes that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested.

Rejection of Claims 1-21 Under 35 U.S.C. §102(a)

Claims 1-21 stand rejected under 35 U.S.C. §102(a) as being anticipated by La Medica Jr. *et al* (U.S. Patent No. 6,625,451).

La Medica reference

La Medica describes a System Select feature having four user selectable modes of operation:

- Home Only mode - use only a home system;
- PRL Only mode - use (1) the home system or (2) a system in a preferred roaming list (PRL);
- PRL Preferred mode - use (1) the home system, (2) a system in the PRL, or (3) a system in the same frequency band as the home system; and
- PRL-Non Preferred mode - use (1) the home system, (2) a system in the PRL, (3) a system in the same frequency band as the home system, or (4) a system on any frequency band.

In La Medica, the selected mode determines which systems are available for use to obtain service. In each mode, the available systems are selected in a specific order of preference, which is indicated by the numbers within parentheses above. All of the systems in the PRL may be used to obtain service in the PRL Only mode, the PRL Preferred mode, and the PRL-Non Preferred mode.

The Claims

Claim 1 of the present invention, as amended, recites:

Appl. No. 10/043,695
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"In a mobile station including a preferred roaming list of wireless communications systems, a system acquisition procedure comprising the steps of:

maintaining a list of unusable wireless communications systems, each entry of a wireless communications system in the list of unusable wireless communications systems including a system identifier and corresponding avoidance criterion for not using the wireless communications system;

selecting a wireless communications system from the preferred roaming list of wireless communications systems in accordance with a predetermined system acquisition sequence, each entry of a wireless communications system in the preferred roaming list including a system identifier;

determining whether the selected wireless communications system from the preferred roaming list is a useable wireless communications system or an unusable wireless communications system;

attempting to acquire and register with the selected wireless communications system when the selected wireless communications system is determined to be a useable wireless communications system; and

repeating the step of selecting when the selected wireless communications system is determined to be an unusable wireless communications system,

wherein the selected wireless communications system is determined to be an unusable wireless communications system when a system identifier for the selected wireless communications system matches a system identifier in the list of unusable wireless communications systems and when avoidance criterion corresponding to the system identifier in the list of unusable wireless communications systems is satisfied."

Applicant submits that Claim 1 is not anticipated by La Medica for at least the following reasons.

First, La Medica does not disclose "maintaining a list of unusable wireless communications systems, each entry of a wireless communications system in the list of unusable wireless communications systems including a system identifier and corresponding avoidance criterion for not using the wireless communications system," as recited in Claim 1. The rejection indicates that the avoidance criterion of Claim 1 is anticipated by "set time period or until the completion of one call then exits" of La Medica. Applicant submits that this is not the case. The avoidance criterion in Claim 1 indicates when a wireless communications system is not used to obtain service. In contrast, the "set time period or until the completion of one call" in La Medica indicates how long a system can be used. La

Appl. No. 10/043,695
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Medica thus discloses "usable" criterion, which is opposite of the avoidance criterion in Claim 1.

Second, La Medica does not disclose "determining whether the selected wireless communications system from the preferred roaming list is a useable wireless communications system or an unusable wireless communications system," as recited in Claim 1. In La Medica, all systems in the PRL are usable. If more than one preferred system in the PRL is available, then station 3 selects and registers with the most preferred system. La Medica does not disclose determining whether a given system in the PRL is usable or unusable.

Third, La Medica does not disclose "wherein the selected wireless communications system is determined to be an unusable wireless communications system ... when avoidance criterion corresponding to the system identifier in the list of unusable wireless communications systems is satisfied," as recited in Claim 1. The rejection indicates that this feature of Claim 1 is disclosed in column 18, lines 30-65 and column 20, lines 27-45 of La Medica. Column 18, lines 30-65 describes the PRL-Non Preferred mode. In this mode, all systems are usable to obtain service but are selected in a specific order of preference - starting with the home system, then a system in the PRL, then a system in the same band as the home system, and finally a system in any band. Column 20, lines 27-45 describes transitioning out of the PRL-Non Preferred mode after a set period of time or at the end of one call. La Medica does not disclose determining whether a system in the PRL is unusable when avoidance criterion for the system is satisfied.

For at least the above reasons, Applicant submits that Claim 1 is not anticipated by La Medica. Claims 2-11 are dependent on Claim 1 and are not anticipated by La Medica for at least the reasons noted for base Claim 1.

Applicant submits that Independent Claim 12 is not anticipated by La Medica for at least the following reasons. First, La Medica does not disclose "maintaining a list of unusable wireless communications systems, each entry of a wireless communications system in the list of unusable wireless communications systems including a system identifier and corresponding avoidance criterion for not using the wireless communications system," as noted above for Claim 1.

Second, La Medica does not disclose "adding a record to the list of unusable wireless communications systems, the added record including an identifier of the currently selected wireless communications system and corresponding avoidance criterion based on the detected

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PATENT
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communications failure, wherein the currently selected wireless communications system is unusable while the corresponding avoidance criterion is satisfied." La Medica discloses displaying a "No Service" indicator if none of the allowed systems are found and displaying a "Roam" indicator if a system in the PRL is being used. However, La Medica does not disclose generating a record for a system with a communications failure. La Medica also does not disclose barring the failed system from use while the corresponding avoidance criterion is satisfied.

For at least the above reasons, Applicant submits that Claim 12 is not anticipated by La Medica. Claims 13-16 are dependent on Claim 12 and are not anticipated by La Medica for at least the reasons noted for base Claim 12.

Independent Claim 17 has been amended to recite the features noted above for Claim 1. Claims 18-21 are dependent on Claim 17. Claim 17-21 are not anticipated by La Medica for at least the reasons noted for Claim 1.

Accordingly, the §102(a) rejection of Claims 1-21 should be withdrawn.

New Claims

New claims 22-24 recite additional features of the invention. Independent Claim 22 recites some key features of Claim 1 and are not anticipated by La Medica for at least the reasons noted above for Claim 1.

CONCLUSION

In light of the amendments contained herein, Applicant submits that the application is in condition for allowance, for which early action is requested.

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Respectfully submitted,

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